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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,691	10/28/2003	Tsutomu Noguchi	FUJZ 20,700	3923
26304 7590 06/12/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
ALIA, CURTIS A				
ART UNIT		PAPER NUMBER		
2416				
MAIL DATE		DELIVERY MODE		
06/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/694,691

**Applicant(s)**

NOGUCHI, TSUTOMU

**Examiner**

Curtis A. Alia

**Art Unit**

2416

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.4.6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.4.6 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 18 February 2009 has been entered. Claims 5 and 10 are cancelled and claims 1, 4, 6 and 9 are amended. Claims 1, 4, 6 and 9 are pending in this application, with claims 1 and 6 being independent.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

Applicant's arguments filed 18 February 2009 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Pyke fails to disclose generating a dual purpose normally-transferred and monitored frame, the Examiner respectfully disagrees. The replicator 22 generates a packet as a packet is received, from which it then replicates. Once the two replicated packets are generated (normally-transferred and monitored packets), they can be stripped of their original headers (see paragraph 32) so that new headers can be added so that they are delivered to their intended recipients.

Regarding applicant's argument that the frame does not have unique in-device information, the Examiner respectfully disagrees. In particular, it is unclear, both from the claims and from the specification, as to what the in-device information is. Therefore, the Examiner is interpreting in-device information as a hardware address for the destination of each

packet. Therefore, it is safe to assume that when the replicator of Pyke replicates the packet and strips and replaces the header information of each packet to match the proper destination, that this in-device information is also changed for proper receipt by the associate and/or law enforcement agency. This process makes the in-device information of the normally-transferred frame "unique" because it differs from the information in the monitored frame that is destined for another device.

*Claim Rejections - 35 USC § 103*

2. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable by Pyke et al. (previously cited US 2003/0179747) in view of Anderson et al. (previously cited US 6,262,979).

Regarding claim 1, Pyke discloses a frame transfer method comprising: a first step of determining whether or not the received frame is to be monitored (see paragraph 31, lines 2-3, call is targeted for monitoring), and generating, from the received frame, a single dual-purpose normally-transferred and monitored frame including the destination address and in-device information when the received frame is found to be monitored (see paragraph 31, frame is received by replicator and a frame is prepared for the replication process, the frame comprising a header, a header normally includes a destination address (IP) and a hardware (MAC) address (in-device information)), a second step of generating two frames (see paragraph 31, the packet payload is copied into two copies, one for monitoring, the other for the recipient), a third step of editing one of the two frames to generate a monitored frame including the in-device information without the destination address (see paragraph 31, the two replicated frames are fitted with new

headers corresponding to their destinations, the monitored frame does not contain the destination address, but a new destination (the monitoring station)) and editing the other of the two frames to generate a normally-transferred frame including the destination address without the in-device information (see paragraph 31, the other replicated packet contains the header with the original destination address for transferring it normally to the intended recipient), and a fourth step of establishing a path corresponding to each of the two frames (see paragraph 31, the headers are modified so that the packets are delivered to the appropriate destinations, thus requiring that the path be established).

Pyke does not explicitly teach that the monitored frame and the normally-transferred frame are generated by multicasting.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Anderson. In particular, Anderson teaches that the monitored frame and the normally-transferred frame are generated by multicasting (see column 2, lines 31-45, multicast packets can be generated for transmitting a packet to multiple destinations).

In view of the above, having the method of Pyke, then given the well-established teaching of Anderson, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke as taught by Anderson, since Anderson stated that timely detection of collisions of packets is improved.

Pyke and Anderson do not explicitly teach the network processor determines based on a destination address in header information of the received frame.

However, the above-mentioned claimed limitation is well-known in the art, as evidenced by Kung. In particular, Kung teaches that the network processor determines based on a

destination address in header information of the received frame (see column 2, lines 31-39, the watchdog software identifies activity from a designated telephone or directory number DN or IP address as being the target for monitoring).

In view of the above, having the method of Pyke and Anderson, then given the well-established teaching of Kung, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke and Anderson as taught by Kung, since Kung stated in column 1, lines 48-51 that a user of the monitoring phone can be alerted to surveillance of a call.

Regarding claim 6, Pyke discloses a frame transfer apparatus comprising: a network processor determining whether or not the received frame is to be monitored (see paragraph 31, lines 2-3, call is targeted for monitoring), and generating, from the received frame, a single dual-purpose normally-transferred and monitored frame including the destination address and in-device information when the received frame is found to be monitored (see paragraph 31, frame is received by replicator and a frame is prepared for the replication process, the frame comprising a header, a header normally includes a destination address (IP) and a hardware (MAC) address (in-device information)), a local switch generating two frames (see paragraph 31, the packet payload is copied into two copies, one for monitoring, the other for the recipient), the network processor editing one of the two frames to generate a monitored frame including the in-device information without the destination address (see paragraph 31, the two replicated frames are fitted with new headers corresponding to their destinations, the monitored frame does not contain the destination address, but a new destination (the monitoring station)) and editing the other of the two frames to

generate a normally-transferred frame including the destination address without the in-device information (see paragraph 31, the other replicated packet contains the header with the original destination address for transferring it normally to the intended recipient), and a switch portion establishing a path corresponding to each of the two frames (see paragraph 31, the headers are modified so that the packets are delivered to the appropriate destinations, thus requiring that the path be established).

Pyke does not explicitly teach that the monitored frame and the normally-transferred frame are generated by multicasting.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Anderson. In particular, Anderson teaches that the monitored frame and the normally-transferred frame are generated by multicasting (see column 2, lines 31-45, multicast packets can be generated for transmitting a packet to multiple destinations).

In view of the above, having the method of Pyke, then given the well-established teaching of Anderson, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke as taught by Anderson, since Anderson stated that timely detection of collisions of packets is improved.

Pyke and Anderson do not explicitly teach the network processor determines based on a destination address in header information of the received frame.

However, the above-mentioned claimed limitation is well-known in the art, as evidenced by Kung. In particular, Kung teaches that the network processor determines based on a destination address in header information of the received frame (see column 2, lines 31-39, the

watchdog software identifies activity from a designated telephone or directory number DN or IP address as being the target for monitoring).

In view of the above, having the method of Pyke and Anderson, then given the well-established teaching of Kung, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke and Anderson as taught by Kung, since Kung stated in column 1, lines 48-51 that a user of the monitoring phone can be alerted to surveillance of a call.

3. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyke in view of Anderson and Kung as applied to claims 1 and 6 above, and further in view of Foti (previously cited US 6,839,323) and Maher et al. (newly cited US 2003/0179758).

Regarding claim 4, Pyke, Anderson and Kung do not explicitly teach that the header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring, the header information of the frame having the original flag is restored to the normally-transferred ID and the header information of the frame having the monitored flag is rewritten into a CPU-transferred ID.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Foti. In particular, Foti teaches that the header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring (see column 5, lines 15-26, a header is added to a packet



including information necessary for transmission, including a Call ID as well as the ability to restore the original packet), and upon generating the normally-transferred frame and the monitored frame respectively, the header information of the frame is restored to the normally-transferred ID and the header information of the frame is rewritten into a CPU-transferred ID (see column 5, lines 20-24, decapsulating the packet from the new header restores the original packet information).

In view of the above, having the method of Pyke, Anderson and Kung, then given the well-established teaching of Foti, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke, Anderson and Kung as taught by Foti, since Foti stated that monitoring can be applied to IP networks, including mobile networks.

Pyke, Anderson, Kung and Foti do not explicitly teach that upon the multicasting the two frames, the monitored ID of the dual-purpose frame is respectively rewritten into an original flag and a monitored flag.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Maher. In particular, Maher teaches that upon the multicasting the two frames, the monitored ID of the dual-purpose frame is respectively rewritten into an original flag and a monitored flag (see paragraph 37, when performing the wiretapping functionality, the QoS processor is able to modify the packet by adding or modifying any fields in the header to achieve the QoS required, including setting any flags to classify the packet as either an original packet or a monitored packet).

In view of the above, having the method of Pyke, Anderson, Kung and Foti, then given the well-established teaching of Maher, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke, Anderson, Kung and Foti as taught by Maher, since Maher stated that detailed records of the communications can be maintained.

Regarding claim 9, Pyke, Anderson and Kung do not explicitly teach that the header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring, upon generating the normally-transferred frame and the monitored frame respectively restores the header information of the frame having the original flag to the normally-transferred ID and rewrites the header information of the frame having the monitored flag is rewritten into a CPU-transferred ID.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Foti. In particular, Foti teaches that the header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring (see column 5, lines 15-26, a header is added to a packet including information necessary for transmission, including a Call ID as well as the ability to restore the original packet), the network processor, upon generating the normally-transferred frame and the monitored frame respectively restores the header information of the frame to the normally-transferred ID and rewrites the header information of the frame is rewritten into a CPU-transferred ID (see column 5, lines 20-24, decapsulating the packet from the new header restores the original packet information).

In view of the above, having the apparatus of Pyke, Anderson and Kung, then given the well-established teaching of Foti, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the apparatus of Pyke, Anderson and Kung as taught by Foti, since Foti stated that monitoring can be applied to IP networks, including mobile networks.

Pyke, Anderson, Kung and Foti do not explicitly teach the local switch, upon the multicasting, the two frames having the monitored ID of the dual-purpose frame respectively rewritten into an original flag and a monitored flag.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Maher. In particular, Maher teaches that the local switch, upon the multicasting, the two frames having the monitored ID of the dual-purpose frame respectively rewritten into an original flag and a monitored flag (see paragraph 37, when performing the wiretapping functionality, the QoS processor is able to modify the packet by adding or modifying any fields in the header to achieve the QoS required, including setting any flags to classify the packet as either an original packet or a monitored packet).

In view of the above, having the method of Pyke, Anderson, Kung and Foti, then given the well-established teaching of Maher, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke, Anderson, Kung and Foti as taught by Maher, since Maher stated that detailed records of the communications can be maintained.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis A. Alia whose telephone number is (571) 270-3116. The examiner can normally be reached on Monday through Friday, 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung S. Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aung S. Moe/  
Supervisory Patent Examiner, Art Unit 2416

/Curtis A Alia/  
Examiner, Art Unit 2616  
6/5/2009

CAA